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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Theodore M. Lach III	Art Unit:	1773
Serial No.:	10/612,091	Examiner:	Monique R. Jackson
Filed:	July 2, 2003	Conf. No.:	5805
For:	SEALING SYSTEM AND PROCESS THEREFOR		
Attorney Docket No:	13822		

I, Paul F. Donovan, hereby certify that this paper is being transmitted by facsimile to the U.S. Patent Office at (571)-273-8300, on the date of my signature:

November 3, 2005
Date

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This communication responds to the Office Action mailed October 18, 2005.

The Examiner has identified in the application two groups of claims and has required restriction to one of these groups. The groups are Group I (claims 1, 4-7 and 9) drawn to a sealant material, and Group II (claims 10-20) drawn to a method of sealing. Applicants' attorney elects to prosecute the claims of Group I with traverse, as further set forth below, and respectfully requests reconsideration of the restriction requirement.

Applicants' attorney respectfully traverses the restriction requirement for at least the following reasons. The subject application was originally filed with claims 1-20. A first substantive office action examining all of the pending claims 1-20 was mailed on May 18, 2005. A response was filed on July 27, 2005 in response to the first office action. Although a restriction requirement is generally at the discretion of the Office and can be given at anytime during the prosecution of an application, the rules clearly state that the Office should issue restriction

requirements as early as possible during prosecution so as not to prejudice the applicant. In this case, the Examiner has already issued a substantive action on all of the pending claims and it seems unfair to now subject the applicant to the burdens associated with a restriction requirement. The amendments to the claims in response to the first office action did not change the claims in such a way that a restriction requirement is anymore warranted now than it could have been when the case was originally filed. For this reason alone, it is respectfully requested that the Examiner reconsider and withdraw the current restriction requirement.

Even if the Examiner is not persuaded for the reasons noted above to withdraw the restriction requirement, the sealant of Group I and the method of sealing of Group II are so inextricably related to one another that they should be examined in a single application. Applicants submit that the subject matter of Group I is sufficiently related to the subject matter of Group II as to be easily prosecutable therewith. Under 35 U.S.C. § 121, the U.S. Patent and Trademark Office has the authority to require an applicant to restrict an application which claims "two or more independent and distinct inventions" to one of the inventions. However, the inventions claimed in Groups I and II of the present application are sufficiently related to one another to warrant concurrent prosecution in the same application. A review of the claims of Group I illustrates that the limitations recited therein are also expressly included as elements of various process claims of Group II.

Applicants respectfully submit that co-prosecution of all the claims in the present application is required in the interests of administrative efficiency. A complete and thorough search of the prior art for either the sealant or the method of sealing would require a search of the subject matter of the other. The search for Group I would also be required for Group II because the same limitations claimed in Group I are included as elements of certain method claims of Group II. This is even more apparent given the fact that the Examiner has already issued a substantive action regarding the claims of both Groups. Thus, it is respectfully submitted that there will not be a serious burden placed on the Examiner if restriction is not required, because a search considering the limitations found in each of the claims will require a review of the all of the

classifications identified by the Examiner.

Practicality and efficiency and a lack of serious burden on the Examiner dictate that the claims should be retained in a single application and the restriction requirement should be withdrawn. The restriction requirement, if sustained, will prejudice the applicants because of the increased cost to applicants arising from further substantial filing fees and prosecution costs.

Furthermore, given the close relationship between the claims of Group I and II, prosecution in the same application would be administratively efficient for the U.S. Patent and Trademark Office. Specifically, by prosecuting the Groups of Inventions together, searches could be consolidated, and one Examiner could readily examine the subject matter of all the claims of this application at once.

The Examiner has also indicated that the application contains claims directed to patentably distinct species; namely, species A (claims 10-18) and species B (claims 19-20). The applicants elect, with traverse, the claims of species A for prosecution in this application. Since it is respectfully argued that the restriction requirement is improper, all of the pending claims should be examined in the subject application. However, at the very least, the claims of species A should be examined with the claims of Group I because of the similar composition limitations recited in each.

In view of the foregoing, withdrawal of the restriction/election requirement is respectfully requested. Should the Examiner believe that a telephone interview would expedite prosecution and allowance of the present application, or address any outstanding formal issues, she is respectfully requested to contact the undersigned.

November 3, 2005

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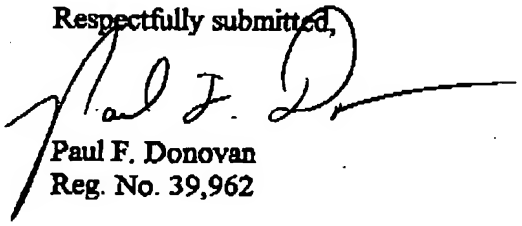
Respectfully submitted,



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